

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yano et al., U.S. Patent # 6,077,986 in view of Nakagawa et al., U.S. Patent Application Publication No. 2002/0137841.

It is Applicant's position that the claims are patentable over the prior art of record both because (i) the combination of references does not contemplate the particular benefit associated with adding the claimed ester compound (II) to the silylated vinyl polymer (I) espoused by their Specification, (ii) the observations summarized in Table 5 are unexpected.

Concerning the first point, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). That is to say, the Examiner needs not to rely on the same rationale, the realization of a composition with improved storage stability, for combining the individual elements of claimed invention to justify their combination. The reasons given that explain why the teachings of the aforementioned documents appears to be sound thus this argument would not compel the withdrawal of the rejection.

As for the data outlined in Table 5 of the Specification, the Examiner agrees that there is provided rather limited evidence that some of the ester compounds (II) embraced by the claims do, in fact, appear to have an unexpected influence on the magnitude of the skinning time delay but, of course, this showing is hardly commensurate with the full scope of the claim insofar as esters derived from mono-dicarboxylic acids and also polyglycerol, pentaerythritol, and sorbitan are also embraced by the claims. *Yano*, likewise, discloses ester derivatives of polyglycerol, sorbitan and pentaerythritol and Applicant has not yet illustrated that these compounds exert the same influence over storage stability.

As an aside, the Examiner carried out a modified survey of the art to see if an anticipatory reference was available. Several commonly assigned references, WO00/14127, WO00/20498, and WO 01/55259, all mention an equivalent polymer and the employment of "pentaerythritol esters" as plasticizers. The Examiner could not verify that any of these plasticizers possessed an α,β - or α,γ - diol structure. The embodiments of this class of plasticizers that the Examiner encountered were ones wherein all of the hydroxyl groups had been esterified.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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October 15, 2008

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796